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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/470,216	12/22/1999	DALE F. MCINTYRE	80121F-P	5901

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PATENT LEGAL STAFF  
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ROCHESTER, NY 14650-2201

EXAMINER
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POND, ROBERT M

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 07/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/470,216

Applicant(s)

MCINTYRE ET AL.

Examiner

Robert M. Pond

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 April 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Response to Amendment***

The Examiner is in receipt of applicant's response to the office action dated 12 April 2002. The applicant's remarks have been fully considered and after due diligence they have been found moot and worthy of rejection in view of new references cited. The U.S. Patent and Trademark Office withdraws the previous non-final action and apologizes to the applicant for any inconvenience incurred.

Applicant's arguments are addressed in the Detailed Action below, but as per independent claim 1, Applicant's traverse relies on references made in col. 4, lines 34-36 and col. 8, lines 41-43 and therefore argues that Shiota et al. does not teach nor suggest automatically providing a product after reaching a predetermined criteria. The Office Action discloses Shiota et al as teaching a system and method of providing customers with a photographic service via a network, disclosing a fulfillment center that manages customer orders and images, minilabs, special laboratories, and customers connected remotely via the Internet for viewing and ordering images as noted in the first action. The office action continues to cite Shiota et al. as teaching order information comprising one or more formats (Figs. 2 and 3). This examiner notes the following teachings from Shiota et al.:

***(Col. 7, lines 3-14)***

In the system shown in FIG. 8, a customer 1 asks for first prints from an agency 13 (121). The first prints may be generated by the agency 13 itself or by a wholesale lab 14 following a request from the agency 3. In each case, a film (122) from the customer 1 is temporarily handed to the wholesale lab 14 (122). The wholesale lab 14 reads the film using a scanner 7 or the like, and stores pictures recorded on the film in an image server 15 as digital image data. If first prints have been ordered from the wholesale lab, the prints are generated by a

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printer 9 or the like, and delivered to the agency 13 (123), and then handed to the customer 1 via the agency 13 (124).

*(Col. 7, lines 15-21)*

After the image server 15 has stored digital image data, the customer 1 can access the image server 5 via the Internet 5 (125), and order an extra print or the like looking at the stored picture image data on a display screen. In response to this order, the image server 15 generates a print using the printer 9 or the like, and hands the print to the customer 1 (127) by mail or via the agency (126).

*(Col. 7, lines 46-57)*

In the embodiment shown in FIG. 1, digital image data input is carried out by the minilab 3. When the customer orders first prints to the minilab 3, the minilab 3 reads a film using a scanner 7 and generates first prints using a printer 9. The digital image data read by the scanner 7 are stored in a laboratory server 8 after the generation of the first prints. On this occasion, low resolution image data which are the digital image data in a reduced resolution (hereinafter called a thumbnail image) are generated and transferred to a center server 12 in the service center 2. The laboratory server 8 stores not only the digital image data of the customer but also a template thereof.

*(Col. 9, lines 40-52)*

The laboratory server 8 which received the order information carries out the processing such as outputting an extra print according to the content of the order included in the order information, and hands the print to the customer or arranges mailing or the like. On this occasion, the hand-over to the customer or a mailing arrangement should be carried out by hand, as has been carried out conventionally. However, the laboratory server 8 can carry out processing to help such operations, for example, to print a mailing label automatically by referring to the order information data showing the recipient, and to notify the recipient of the print output finish by automatically sending him/her an electronic mail.

*(Col. 10, lines 4-17)*

The customer refers to (and downloads upon necessity) the low resolution image data 22 and the low resolution template 24 disclosed on the center server 12 and composes them using the personal computer 6. However, the processing carried out at this stage, such as composition, aims to generate the order information, and the processed image obtained through the processing is used for confirmation only. The procedure of the processing carried out by the customer is recorded by the function of dedicated software installed in the personal computer 6. The procedure is taken in as a portion of the order information 20 when the order information is generated. The order information

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20 also includes information showing an image 22a and a template 24a specified and used by the customer.

*(Col. 10, lines 18-29)*

The order information 20 is received by the center server 12, and the center server 12 transmits instruction information 25 to the laboratory selected by referring to the order information 20. At this time, the instruction information 25 includes the information showing the image 22a, the template 24a, and the processing procedure. The laboratory server 8, which receives the instruction information including such information, searches the hard disc for the high resolution template 23a corresponding to the template 24a and high resolution image data 21a corresponding to the image 22a, based on the information, and outputs the print after the processing following the processing procedure.

This examiner finds the Applicant's arguments as unpersuasive. Shiota et al teaches order information that is carried out automatically according to predetermined criteria established by the customer as conveyed through the ordering procedure. To derive the benefits of the invention disclosed by Shiota et al, customers must take the action of generating order information. The system automatically processes the order information by printing a set of "first prints" and automatically places images on the web server for private viewing, automatically alerts the customer to the presence of these digital images, and automatically alerts the customer to a pending expiration time to place orders for extra prints.

## **DETAILED ACTION**

### ***Drawings***

1. This application has been filed with informal drawings, which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

### ***Specification***

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or

(2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**3. Claims 1-4, 8, and 9 are rejected under 35 USC 102(e) as being anticipated by Shiota et al, patent number 6,324,521.**

Shiota et al teaches all the limitations of Claims 1-4, 8, and 9. For example, Shiota et al discloses a system and method of Fuji Photo Film Company of providing customers with a photographic service via a computer network. Shiota et al teaches a fulfillment center managing one or more orders, routing photo processing jobs to minilabs and special laboratories, processing and delivering automatically to the customer a first set of prints, and customers connecting remotely to the service via the Internet for viewing, ordering extra prints or other products and services, and sharing with friends (see at least abstract; Fig. 1 (1, 2, 3, 4, 5); Fig. 6 (36); Fig. 7 (6); col. 1, lines 54-67; col. 2, lines 1-9; col. 2, lines 56-67; col. 7, lines 58-62). Shiota et al teaches image retaining devices comprising one or more rolls of photographic film, creating a first set of prints and then electronically scanning and converting into digital images for online viewing (see at least Fig. 1 (7); col. 2, lines 33-41), storing digital images in databases (see at least Fig. 6 (33, 34, 38, 40); col. 10, lines 65-67; col. 11, lines 1-12), and automatically providing a product after reaching a predetermined criteria (col. 9, lines 40-52, col. 10, lines 4-29). Registration information for an order comprises a

reception number unique to the order, a processing number unique to the service requested for the images being supplied, and a plurality of image numbers or image identification (ID) numbers, each being unique to the associated digital image (see at least Fig. 2; col. 3, lines 31-35). Shiota et al teaches the use of a web browser plug-in to facilitate browsing and image viewing, and processing application software to manipulate images prior to ordering goods or service. Shiota et al teaches services and goods such as outputting prints, extra prints, picture postcard, and compact disc (CD) (see at least Fig. 6 (11); col. 10, lines 54-58), generating pass codes for online access, and arrangements or images in an album (see at least col. 4, lines 28-42). Shiota et al further teaches ordering information comprising one or more formats (see at least Figs. 2; col. 6, lines 46), of which the format in Fig. 2 discloses a unique reception number that is used as a registration number for an image retaining device, each image retaining device number comprising at least one image identified by an image number. Shiota et al further discloses an hierarchical approach to order information processing (see at least Fig. 3; col. 6, line 47) whereby in Fig. 3 Order Information 1 represents ordering information for the first image retaining device, Order Information 2 represents the ordering information of the second image retaining device, and etc., whereby the print order file comprises a group or subgroups associated with a print order.



***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 4. Claims 5-7, 10-60, and 62-76 are rejected under 35 USC 103(a) as being unpatentable over Shiota et al, in view of London Drug (a collection of articles cited in PTO-892 Items: U and V), and in further view of Komiya et al, patent number 6,155,025.**

Shiota et al teaches all the above as noted under the 102(e) rejection and further teaches use of photographic film, photographic film having an image ID number for each image on the film roll, a processing number that pertains to the type of service or services to be performed, a unique reception number to track the order, and an access code for Internet access, but fails to specifically disclose how the reception number is generated or its association with a roll of film. London Drugs (Item U) teaches a photo service providing digital photo finishing by loading customer photos to the Internet. At London Drugs, a customer's roll of film is processed into prints, each individually checked for quality, securely loaded to the Internet web site, and optionally loaded into a private album. London Drug emails a personal roll ID code to the customer that creates a hot link directly connecting the customers' e-mail to the London Drug

web site. Using the personal roll ID code assigned to each roll of film, a customer and their family or friends can retrieve the photographs from anywhere in the world over the Internet (see page 1). London Drugs (Item V) further teaches London Drug's Photo Station, Fuji's Picture Plus, and Kodak's Picture Maker having similar services, and specifically discloses the use of the roll ID to access images over the London Drug web site (see page 1). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Shiota et al, to assign unique ID numbers to each roll of film as taught by London Drug, in order to provide better image management and convenience for customers, and for associating one or more roll ID numbers with an Internet posting service or optional album posting.

Shiota et al and London Drug teach all the above as noted under the 103(a) rejection and further teach customer ordering convenience, issuing unique roll IDs to customers to facilitate convenience, and checking for quality during print processing, but fail to disclose a) providing roll IDs based on the roll ID supplied with the roll of film, b) associating multiple rolls of film with the package ID during registration, and c) photographic service receiving roll IDs into a database.

Komiya et al teaches a system and method of Fuji Photo Film Company packaging photographic film comprising individually packaged roll of film and multiple rolls of film packaged in a single package. Komiya et al teaches each packaged roll of film having a unique ID number printed on the film, the cartridge, and the package. Komiya et al further teaches packaging containing multiple rolls

as having a package ID that relates to each roll ID in the package, a central production information management system that retains ID information for quality and historical tracking purposes, detecting quality failures after film product is sold, and using ID information to effect recalls (see at least abstract; Fig. 2 (10, 14b, 32, 26, 40a, 40b); Fig. 21 (306b, 310b); col. 9, line 66 through col. 10, line 27; col. 11, lines 18-25; col. 16, lines 48-64; col. 20, lines 36-47; col. 22, lines 22-64). Komiya et al, however, fails to disclose transmitting Fuji Photo Film's roll and package ID information to its networked photographic service. This examiner takes the position that the manufacturing arm of Fuji Photo Film derives benefit from a quality improvement and product recall tracking perspective to share the ID information with the Fuji Photo Film networked photographic service. Any problems with film quality detected at the print processing end would automatically be correlated with the roll ID information. There is also the potential for marketing campaigns to emphasize the added quality benefits of the networked photographic system and the use of Fuji film. Furthermore, once the networked photographic service has the ID information it can associate packaged roles to one another just as the sister organization does for internal tracking purposes. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Shiota et al, London Drug, and Komiya et al to share roll and package ID information in order to create a closed-loop quality system beneficial to improving customer satisfaction,

convenience, and furthering positive market perceptions of Fuji Photo's film quality and quality initiatives.

- 5. Claim 61 is rejected under 35 USC 103(a) as being unpatentable over Shiota et al, London Drug, and Komiya et al, in further view of Egan, patent number 6,273,986.**

Shiota et al, London Drug, and Komiya et al teach all the above as noted under the 103(a) rejections and further teach printing unique film roll IDs on packages, but fail to teach a removable label that hides the ID. Egan teaches composite labels, package labeling systems and methods where the composite label serves as a combination of shipping label and packing list label with the shipping bar code indicia or other suitable indicia used for tracking purposes and identifying the contents of the package noted on the packing list (see at least abstract; col. 2, lines 32-36; col. 4, lines 18-22). The user removes the shipping label to reveal the packing list that identifies package contents (see at least col. 3, lines 22-51). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Shiota et al, London Drug, and Komiya et al to incorporate a removable label with hidden indicia as taught by Egan, in order to hide the unique roll ID from everyone other than the customer who purchased the film product.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EDT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ms. Wynn Coggins** can be reached on 703-308-1344.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***


or faxed to:

**703-305-7687** (Official communications; including After Final communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

RMP

June 21, 2002

  
**WYNN W. COGGINS**  
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